

PROTECTING YOUR INTELLECTUAL PROPERTY

An Ounce of Precaution...

PURPOSE OF PRESENTATION

- Provide a concise review of IP in procurement.
- Discuss Possible Trouble Areas
- Suggest Prudent Precautions

INTELLECTUAL PROPERTY

- There are four types:
 - Patents
 - Copyrights
 - Trademarks
 - Trade Secrets
- The subject matter and the rights under each are different and the remedies available to the owner are different.

PATENTS

- SUBJECT MATTER A new and useful process, machine, article of manufacture, composition of matter or any improvement.
- RIGHTS The right to exclude others from making, using, offering for sale, selling, or importing.**No right to do any of the above
- REMEDIES AGAINST GOVERNMENT
They are limited by 28 USC 1498; Only a reasonable compensation; No injunctions

COPYRIGHTS

- SUBJECT MATTER An original work of authorship fixed on any tangible medium.
- RIGHTS The right to copy, prepare derivative works, distribute and perform.
- REMEDIES AGAINST GOVERNMENT
_ They are limited by 28 USC 1498; Only a reasonable compensation; No injunctions.

TRADEMARKS

- SUBJECT MATTER Any word, name, symbol, device or combination used to identify and distinguish goods and indicate the source.
- RIGHTS The right to use the mark and prevent others from copying and counterfeiting.
- REMEDIES AGAINST GOVERNMENT
Injunctions and damages.

TRADE SECRETS

- SUBJECT MATTER Information having commercial value that is secret.
- RIGHTS The right to control disclosure and use of the information.
- REMEDIES AGAINST GOVERNMENT
Injunctions and damages. **Government employees are also subject to criminal sanctions under The Trade Secrets Act.

FOIA & TECHNICAL DATA

- FOIA – Freedom of Information Act
- The Government must release data, even to your competitors, unless an exemption exists.
- The most common exemption is #4 which exempts from mandatory disclosure:
 - Trade secrets
 - Person's commercial or financial information
 - Confidential or privileged information.
- It covers proposals and delivered data.

PRUDENT PRECAUTIONS

PATENTS

- AN INVENTION NOT COVERED BY A FUNDING INSTRUMENT IS ONE THAT HAS BEEN CONCEIVED AND ACTUALLY REDUCED TO PRACTICE.
 - Have documentation and proof of both. A patent is not an actual reduction to practice or proof of one.
- A CONTRACTOR MAY RETAIN TITLE OF AN INVENTION MADE DURING FUNDED WORK IF CERTAIN CONDITIONS ARE MET.
 - Campbell Plastics Case
- INTENTIONALLY FALSIFYING AN INVENTION REPORT IS PROCUREMENT FRAUD.

PRUDENT PRECAUTIONS

TECHNICAL DATA & SOFTWARE

- **Funding Affects Rights**
 - **Funding from another activity or agency must be considered.**
 - **Any Gov't funding entitles Gov't to GPLR.**
 - **Gov't may require proof. No proof; you lose.**
- **Technical Data & Computer Software to be delivered with rights restrictions must be identified in proposal and contract and updated as changes occur.**
- **Data & software must be clearly & correctly marked.**
 - **Use the markings specified in DFARS.**
 - **Only mark data that should be marked.**

PRUDENT PRECAUTIONS TECHNICAL DATA & SOFTWARE

- INCLUDE IN YOUR PROPOSAL ONLY DATA NEEDED FOR EVALUATION.
- DELIVER ONLY THE DATA REQUIRED BY THE FUNDING AGREEMENT.
- BE REASONABLE IN YOUR NEGOTIATIONS.
- TRY TO UNDERSTAND THE NEEDS AND PURPOSES OF THE PROCUREMENT.

CONCLUSIONS

1. Consult your attorney
2. Be reasonable & accurate
3. Have a basic understanding of intellectual property
4. Have a basic knowledge of the applicable Provisions
5. Identify data rights as early as possible
6. Mark your data clearly & correctly
7. Deliver only what is required for performance